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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,661	04/16/2004	Timm Kuhne	081248-000000US / 61 US	9614
20350	7590	09/26/2006	9	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			EXAMINER LE, HUNG CHARLIE	
			ART UNIT	PAPER NUMBER
			3663	

DATE MAILED: 09/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/826,661	Applicant(s) KUHNE, TIMM	
	Examiner Hung C. Le	Art Unit 3663	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 70 is/are pending in the application.
- 4a) Of the above claim(s) 5 - 6, 15 - 31, 45 - 70 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 - 4, 7 - 14, 32 - 44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>7/2/04 & 7/29/04</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Species of Figure 6 (Claims 1 – 4, 7 – 14, 32 – 44) in the reply filed on 07/12/2006 is acknowledged.

Note: Claims 5 – 6 were cancelled by applicant.

2. Claims 15 – 31, 45 – 70 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Species there being no allowable Generic or linking claim. Election was made **without** traverse in the reply filed on 07/12/2006.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1 – 4, 7 – 14, 32- 44 are rejected under 35 U.S.C. 102(b) as being

anticipated by Faivre (5,509,290).

With respect to claim 1: Faivre (Abstract, Figures 1 – 5, claims) discloses: A die having a cavity for use in a tool set including at least one punch, said die comprising:

an anvil having a surface which defines a bottom of the cavity;

a plurality of die segments; and

a die sleeve disposed circumferentially about the anvil surface and having a plurality of guideways which receive the die segments, wherein the die segments are inwardly spring biased and displaceable outwardly in response to movement of the punch, wherein the die segments are arranged on a supporting surface formed by a die base body having the anvil disposed in its center and each die segment has a radial dimensions which is longer than a radial dimension of the supporting surface.

While patent drawings are not drawn to scale, relationships clearly shown in the drawings of a reference patent cannot be disregarded in determining the patentability of claims. See In re Mraz, 59 CCPA 866, 455 F.2d 1069, 173 USPQ 25 (1972).

With respect to claims 2 & 33: Faivre (Abstract, Figures 1 – 5, Claims) further discloses: wherein the said die is round and the guideways are formed by cutouts in the die sleeve.

With respect to claims 3 & 34: Faivre (Abstract, Figures 1 – 5, Claims) further discloses: comprising at least three die segments designed as ring sections.

With respect to claims 4 & 35: Faivre (Abstract, Figures 1 – 5, Claims) further discloses: wherein the die segments have side faces which extend along secant lines of the supporting surface.

With respect to claims 7 & 38: Faivre (Abstract, Figures 1 – 5, Claims) further discloses: wherein all the die segments have shape which is the same.

With respect to claims 8 & 39: Faivre (Abstract, Figures 1 – 5, Claims) further discloses: wherein the die segments have a circular head piece.

With respect to claims 9 & 40: Faivre (Abstract, Figures 1 – 5, Claims) further discloses: further comprising annular spring element which circumferentially surrounds the die segments and provides spring biasing.

With respect to claims 10 & 41: Faivre (Abstract, Figures 1 – 5, Claims) further discloses: wherein the die segments each have a rear groove which disposes in a circumferential direction and which receives the annular spring element.

With respect to claims 11 & 42: Faivre (Abstract, Figures 1 – 5, Claims) further discloses: wherein the annular spring element comprises an annular spring.

With respect to claims 12 & 43: Faivre (Abstract, Figures 1 – 5, Claims) further discloses: wherein the die sleeve has a thickness which forms a guide length for the die segment guideways.

With respect to claims 13 & 44: Faivre (Abstract, Figures 1 – 5, Claims) further discloses: wherein the anvil is cylindrical.

With respect to claim 14: Faivre (Abstract, Figures 1 – 5, Claims) further discloses: wherein the die sleeve has a hole for engagement of a spring-loaded pin for fastening the die to a die holder on a die holder.

With respect to claim 32: Faivre (Abstract, Figures 1 – 5, Claims) discloses
A die having a cavity for use in a tool set including at least one punch, said die comprising:
an anvil having a surface which defines a bottom of the cavity;
a plurality of die segments; and
a die sleeve disposed circumferentially about the anvil surface and having a plurality of guideways which receive the die segments, wherein the die segments are inwardly spring biased and displaceable outwardly in response to movement

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of the punch, wherein the die sleeve has a hole for engagement of a spring-loaded pin for fastening the die to a die holder on a die holder.

With respect to claim 36: Faivre (Abstract, Figures 1 – 5, Claims) further discloses:

Wherein die segments are arranged on a supporting surface formed by die base body having the anvil disposed in its center.

With respect to claim 37: Faivre (Abstract, Figures 1 – 5, Claims) further discloses:

Wherein the die segments each have a radial dimension which is longer than a radial dimension of the supporting surface.

5. The statements of intended use or field of use, e.g., “for use..., having..., etc...” clauses are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See In re Pearson, 181 USPQ 641; In re Yanush, 177 USPQ 705; In re Finsterwalder, 168 USPQ 530; In re Casey, 512 USPQ 235; In re Otto, 136 USPQ 458; Ex parte Masham, 2 USPQ 2nd 1647.

See MPEP § 2114 which states:

A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ 2nd 1647

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Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. In re Danly, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. Hewlett-Packard Co. v. Bausch & Lomb Inc., 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hung C. Le whose telephone number is 571-272-8757. The examiner can normally be reached on M-F: 07:30am - 05:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack W. Keith can be reached on 571-272-6878. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from

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a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

HCL
09/14/06



JACK KEITH
SUPERVISORY PATENT EXAMINER